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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/772,532	Applicant(s) CUI ET AL.	
	Examiner Julie E. Stein, Esq.	Art Unit 2688	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29 to 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a "modulated data signal," which is non-statutory subject matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 6-7, 9, 16-18, 20, 22-26, 28-30, 31-32, and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0139193 to Buckley.

- a. Buckley discloses all the steps of independent claim 1, including:

A method of managing a communication with a mobile device over a network (Figure 1), comprising:
receiving a first message (paragraph 22);

sending a second message (paragraph 29, SMS message) to the mobile device, wherein the second message includes a message hook (Id., URL);

employing the message hook to access the first message (paragraph 33);

formatting the first message to be readable by a mobile browser (Id. and Figure 5C using HTTP to send the first message, therefore the use of a mobile browser is inherent); and

sending the formatted first message towards the mobile browser (Figure 5D, step 217).

b. The rejection of claim 1 is hereby incorporated. Buckley also discloses all the elements of independent claim 16, including:

A client (paragraph 33, device operating system, BREW) adapted for use in a mobile device to receive messages from a server over a network (Id.), the client being configured to perform actions, comprising:

receiving a first message from the server (paragraph 33), wherein the first message includes a message hook (Id., URL);

employing the message hook to access the second message (Id.), wherein the second message is formatted to be readable from a mobile browser (Id., accessing a HTTP server via HTTP, therefore the use of a mobile browser is inherent).

c. The rejection of claims 1 and 16 are hereby incorporated. Buckley discloses all the elements of independent claim 23, including:

A server (paragraph 29, element 10) for managing a communication with a mobile device over a network, comprising:

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a transceiver for receiving and sending messages to the mobile device (Figure 1 and paragraph 29, it is inherent based on the communication between the hub and the wireless device); and

a transcoder that is configured to perform actions (paragraph 29, this is inherent based on the hub performing the actions indicated below), including:

receiving an alert indicating a first message is available for the mobile device (paragraph 29, data request message);

forwarding a second message to the mobile device (paragraph 29, SMS message), wherein the second message includes a message hook (paragraph 29, URL);

receiving a response to the second message from the mobile device (paragraph 33), including the message hook;

employing the message hook to enable access to the first message (Id.);

formatting the first message to be readable from a mobile browser (see above);

and

sending the formatted first message towards the mobile browser (see above).

d. The rejection of claims 1, 16, and 23 are hereby incorporated. Buckley discloses all the elements of independent claim 29, including:

A modulated data signal for communicating with a mobile device (paragraphs 29 to 33, this is inherent in view of these paragraphs), the modulated data signal comprising the actions of:

receiving an alert indicating a first message is available for the mobile device (paragraph 29, data request message);

sending a second message to the mobile device (paragraph 29, SMS), wherein the second message includes a message hook (Id., URL); and

employing the message hook to access the first message (paragraph 33), wherein the first message is formatted to be readable by a mobile browser (see above).

e. The rejection of claims 1, 16, 23 and 29 are hereby incorporated. Buckley discloses all the elements of independent claim 40, including:

An apparatus for communicating with a mobile device (paragraph 29, element 10), comprising:

A means for receiving a first message (paragraph 29);

a means for sending a second message to the mobile device (Id., SMS), wherein the second message includes a message hook means (Id., URL);

a means for employing the message hook means to access the first message (paragraph 33);

a means for formatting the first message to be readable by a mobile browser (paragraph 33); and

a means for forwarding the formatted first message towards the mobile browser (paragraph 33).

Buckley also discloses all the steps/elements of dependent claims 2, 17, and 28, including wherein formatting the first/second message further comprises formatting the

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message using at least one of a HDML, WMLScript, and JavaScript. See paragraph 26, for example, if a wireless phone is originating the data message, then it is inherent that WMLScript would have to be used to format the data message.

(Id.).

Buckley discloses all the steps of claim 6, including, wherein receiving the first message further comprises receiving at least one of a user account identifier, and a universal message identifier associated with the first message. See paragraph 29, wireless device's identifier.

Buckley also discloses all the steps/elements of dependent claims 7, 18, 25, 31, and 41, including the message hook further comprising a URL. See paragraph 29.

Buckley also discloses all the steps/elements of dependent claims 9, 20, 26, and 32, including wherein the first/second message further comprises at least one of an SMS message, and an MMS message. See paragraph 29.

Buckley also discloses all the elements of dependent claims 22 and 24, including wherein the first/second message further comprises at least one of an email message, an email attachment message, a document, an audio file, a graphics file (paragraph 27), and a video file.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 to 4, 8, 10, 19, 21, 27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of U.S. Patent No. 6,122,485 to Archer.

Buckley does not explicitly teach all the steps of dependent claim 3, including wherein sending the second message further comprises:

- associating a message index with the first message;
- associating the message index with the second message; and
- sending the second message including the associated message index to the mobile device, wherein the message index is usable to locate the first message.

However, Archer teaches a general method and system for messaging in which messages are indexed to a specific caller in order for that caller to later confirm receipt of a sent message. See Figure 2, and column 5, lines 42 to 55. In addition, Archer teaches a method of finding a given message by searching an index table related to the record's position in a sequentially numbered list of records. See column 7, lines 1 to 10.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to include a message index, mapping the first and second messages, because indexing messages is well known as taught by Archer and by indexing the first and second messages, a single index could be used to identify the location of the first message and forwarded to the mobile device to more easily indicate the location of the first message.

Buckley in view of Archer also teaches all the steps of dependent claim 4, including wherein the message index with the first message further comprises employing a one way hash. See Archer, column 6, lines 59 to 65.

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Buckley in view of Archer also teaches all the steps/elements of dependent claims 8, 10, 19, 21, 27, and 33 including wherein the second message further comprises a message index associated with the message (see claim 3), wherein the message index is employable to locate the message (see claim 3) and the message hook further comprises a message index (this would have been obvious to one of ordinary skill in the art at the time the invention was made because it is an additional indication of the location of the message) associated with the message, and a URL (Buckley, paragraphs 29 and 33).

6. Claims 5, 11, 14, 30, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of U.S. Patent No. 6,898,422 to Bern et al.

f. The rejections of claims 1, 16, 23, 29, and 40 are hereby incorporated.

Buckley teaches all the elements of independent claim 34, including:

A system for communicating messages to a mobile device over a network (see above) comprising:

a mobile messaging service (paragraph 29, element 10), coupled to the mobile device (Figure 1), that is configured to perform actions, including:

receiving the alert (paragraph 29);

associating a message hook with the first message (paragraph 29);

sending a second message to the mobile device, wherein the second message includes the message hook (paragraph 29);

a web service (Figure 1, elements 24 and 22 include the internet and Figure 2, which shows element 10, including HTTP servers 114 and 112), coupled to the mobile message service, that is configured to perform actions, including:

- receiving a response to the second message from the mobile device,
- wherein the response employs the message hook (paragraph 33
- retrieving the first message (paragraph 33);
- formatting the first message to be readable by a mobile browser (paragraph 33); and
- sending the formatted first message towards the mobile browser (paragraph 33).

However, Buckley does not explicitly teach a mail transfer service configured to receive a first message and to provide an alert indicating receipt of the first message, and the mail transfer service coupled to the mobile messaging service and the mobile device, where the mobile message service receives the alert from the mail transfer service. However, Buckley does teach the desire to send a "data file" from one wireless device to another wireless device that may represent a "digital image, sound, program instructions, ring tone, or other digital data" and that in the hub 10, the HTTP servers communicate internet protocol messages with the internet. See paragraphs 5 and 23. In addition, Bern teaches a mail transfer service (Figure 1, element 150), which receives email messages, stores them and sends SMS notifications to mobile stations. See column 6, lines 9 to 41. Bern also teaches the use of a message hook, which is a job identifier that uniquely identifies each email. See Bern, column 6, lines 62 to 66.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Buckley to include a mail transfer service as taught by Bern, including a mail transfer service that receives a first message and provides an alert, the mail service being coupled to a mobile messaging service and a mobile device, because the mail transfer service would add additional functionality to the system of Buckley and because Buckley suggests/recognizes that the "data files" may be sent via emails, as they are received at HTTP servers. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to understand that the message hook taught by Buckley (URL, paragraphs 29 and 33) could also include the unique job identifier taught by Bern (column 6, lines 62 to 66).

The rejection of claim 34 is hereby incorporated. Buckley in view of Bern teach all the steps of dependent claim 5, including wherein the first message is stored in a mail farm. See Bern, column 6, lines 62 to 67.

The rejection of claim 34 is hereby incorporated. Buckley in view of Bern teach all the steps of dependent claim 11, including receiving the first message further comprises: receiving the first message by a mail transfer service (see claim 34); storing the first message at a mail farm by the mail transfer service (Bern, column 6, lines 62 to 67, see claim 5). However, Buckley does not explicitly teach associating a universal message identifier with the location of the stored first message. But, Bern teaches assigning a "job identifier" to each email received. See column 6, lines 62 to 66. Therefore, one of ordinary skill in the art at the time the invention was made would have

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included a job identifier (universal message identifier) as taught by Bern in the system/method of Buckley because it further identified and allowed for quick recall of the stored message. See Bern, column 3, lines 30 to 39.

Buckley in view of Bern teaches all the steps/elements of dependent claims 14 and 30, including wherein the first message is an email message. See Bern, column 6, lines 62 to 66.

Buckley in view of Bern teaches all the elements of dependent claim 35, including wherein formatting the first message further comprises formatting the message using at least one of a HDML, WMLScript, and JavaScript. See Buckley, paragraph 26, for example, if a wireless phone is originating the data message, then it is inherent that WMLScript would have to be used to format the data message.

Buckley in view of Bern teaches all the elements of dependent claim 36, including the message hook further comprising a URL. See Buckley, paragraph 29.

7. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of WO 03/030474 A2 to Corrigan et al.

Buckley does not explicitly teach all the steps of dependent claim 12, however, Corrigan does teach all of the additional steps, including logging into an account at a server through the mobile device (page 8, lines 24 to 27); forwarding a device identifier associated with the mobile device to the server (page 8, lines 24 to 27, this would be inherent in the HTTP GET message); receiving at the mobile device a confirmation URL from the server (page 8, lines 10 to 15); responding to the confirmation URL (page 8,

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lines 24 to 27); and if the mobile device is confirmed, registering the mobile device to receive the formatted first message (page 8, line 29 to page 30, line 6).

Therefore, one of ordinary skill in the art at the time the invention was made would have understood that an authentication system, like the one taught by Corrigan could be used to ensure that the message receiver was in fact the correct receiver. See Corrigan, page 5, lines 15 to 25.

Buckley in view of Corrigan teach all the steps of dependent claim 13, including wherein registering the mobile device further comprises associating the device identifier with the account. See Corrigan, page 6, line 4.

8. Claims 37 to 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Bern as applied to claim 34 above, and further in view of U.S. Patent No. 6,122,485 to Archer.

The rejections of claims 3 to 4, 8, 10, 19, 21, 27, and 33 are hereby incorporated. Buckley in view of Bern and further in view of Archer teaches all the elements of dependent claim 37, including wherein the message hook further comprises a message index (see claim 3).

Buckley in view of Bern and further in view of Archer teaches all the elements of dependent claim 38, including wherein the message index further comprises a mapping between a universal message identifier and a device identifier. See, Bern, column 6, line 62 to column 7, line 6.

Buckley in view of Bern and further in view of Archer teaches all the elements of dependent claim 39, including wherein retrieving the first message further comprises:

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determining a message index associated with the message hook (Archer, column 7, lines 20 to 32) and a device identifier (Id.); employing the message index to access a universal message identifier (Bern, column 6, lines 62 to 66, job identifier); and employing the universal message identifier to retrieve the first message (Bern, column 6, line 62 to column 7, line 10). One of ordinary skill in the art at the time the invention was made would have understood that any number of elements could be indexed, such as the messages to each other, the job identifier taught in Bern, a mobile's MSISDN taught by both Buckley and Bern, etc. because the goal with indexing as taught by Archer, is to simplify the identification and look-up of a given record (as in page confirmation). See Archer, column 3, lines 17 to 26.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Bern as applied to claim 1 above, and further in view of U.S. Patent No. 6,865,191 to Bengtsson et al.

Buckley in view of Bern do not explicitly teach all the steps of dependent claim 5, including wherein the first message further comprises an email message and an attachment to the email message. However, Bengtsson teaches a method of sending a SMS message indicating that there is an attachment available and being stored on an attachment server, whose URL is included in the SMS message. See column 5, lines 4 to 36. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Buckley in view of Bern to include the functionality of further including information regarding email attachments, as taught by

Bengtsson because this would allow additional types of data files to be messaged/stored.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,947,738 to Skog teaches a MMS system; U.S. Patent Application Publication No. 2001/0049274 to Degraeve teaches a method of messaging; U.S. Patent Application Publication No. 2002/0107002 to Duncan et al. teaches a system for messaging, which includes URLs; and U.S. Patent Application Publication No. 2004/0043779 to Oliver et al. teaches a method of using text messaging to alert a user to the need to access information on a server.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES


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SUPERVISORY PATENT EXAMINER